



6-10-02

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June 5, 2002

Director of Technology Center 3600
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Washington, D. C. 20231

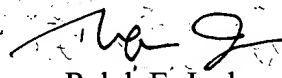
Re: **Patent Application Serial No.: 09/193,565**
Applicants: Drummond, et al.
For: Automated Banking Machine and System
Docket No.: D-1077+2

Sir:

Please find enclosed Applicants' Petition to disregard impermissible new grounds of rejection presented for the first time in the Examiner's Answer filed May 7, 2002 and to disregard and/or clarify material errors in such Answer. If a request for reconsideration is first required, please consider this Petition a request therefore.

No fee is believed due, however any fee should be charged to Deposit Account 09-0428.

Very truly yours,



Ralph E. Jocke

REJ:tcp
Enclosure

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being sent postage prepaid as Express Mail Post Office to Addressee, in an envelope addressed to Director of Technology Center 3600, Commissioner for Patents, Washington, D.C., 20231, this 7th day of June 2002.

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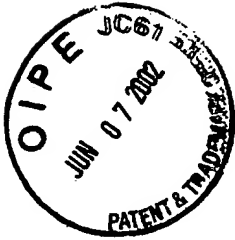
330 • 721 • 0000
MEDINA

330 • 225 • 1669
CLEVELAND

330 • 722 • 6446
FAC&MILE

rej@walkerandjocke.com
E-MAIL

231 South Broadway, Medina, Ohio, U.S.A. 44256-2601



D-1077+2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
Jay Paul Drummond, et al.)	
)	Art Unit 3621
Serial No.: 09/193,565)	
)	
Filed: November 17, 1998)	Patent Examiner
)	Pierre Eddy Elisca
For: Automated Banking)	
Machine and System)	

Director of Technology Center 3600
Commissioner for Patents
Washington, D.C. 20231

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GROUP 3600

Sir:

Appellants petition against the Examiner's Answer ("Answer") dated May 7, 2002 because it contains an impermissible new ground of rejection and because it is defective. If a request for reconsideration is first required, then the petition herein should be considered as such.

**PETITION THAT AN EXAMINER'S ANSWER CONTAINS AN
IMPERMISSIBLE NEW GROUND OF REJECTION**

Applicants respectfully petition that the Answer contains an impermissible new ground of rejection. 37 C.F.R. § 1.193(a)(2) clearly prohibits the entry of a new ground of rejection in an Examiner's Answer. Therefore, Appellants respectfully request that either the Examiner's Answer either be withdrawn or that the new grounds of rejection therein be disregarded.

The status of the claims from which the appeal was taken included the following rejections:

- 1). Claims 1-6, 13-14, and 17-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson et al. ("Anderson").
- 2). Claims 15-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Official notice.

The Answer includes the claim rejections:

- 1). Claims 1-6, 13-14, and 17-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson.
- 2). Claims 15-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson.
- 3). Claims 7-12 were rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson.

As can be seen, the 35 U.S.C. § 102(e) rejections of claims 7-12 were not present in the (Final) Office Action ("Action") dated September 19, 2001 from which the appeal was taken. Nor did the Action include a rejection of claims 15-16 under 35 U.S.C. § 103(a) as being unpatentable over Anderson alone. Thus, these additional rejections constitute impermissible new grounds of rejection.

Furthermore, Appellants also respectfully submit that the arguments presented in their Appeal Brief (filed February 13, 2002) against the claim rejections were based on the Office's interpretation of the references as presented and applied in the Action and from which their appeal was taken. However, the Answer raises new issues, new interpretations, and new

applications of the reference. Therefore, it is respectfully submitted that the Answer contains impermissible new grounds of rejection.

Appellants respectfully submit that the Action includes at least one impermissible new ground of rejection within the meaning of 37 C.F.R. § 1.193(a)(2), which prohibits the entry of a new ground of rejection in an Examiner's Answer. Therefore the inclusion of the new ground of rejection in the Examiner's Answer is legally improper due to noncompliance with the clear wording of both the statute and the regulations, as well as the Office procedures promulgated thereunder. Appellants respectfully request that the Answer either be withdrawn or that the new grounds of rejection therein be disregarded.

Prosecution has not been reopened

The Office's own procedures for examination clearly state that in order to enter a new ground of rejection after Appellants' Brief has been filed, the examiner, with supervisory approval, must reopen prosecution. Note MPEP § 1208.01 and 1208.02. However, there is no indication that prosecution has been reopened. Nor is there any indication of supervisory approval for reopening prosecution.

If necessary, then reconsideration is requested

If a request for reconsideration is first required, then Appellants respectfully request reconsideration and request withdrawal of the Examiner's Answer, or reconsideration and request that the new grounds of rejection be disregarded. If a request for reconsideration is first required, then this petition should be considered as such.

PETITION THAT THE EXAMINER'S ANSWER IS DEFECTIVE

Appellants petition that the Answer is defective and request that the Answer either be withdrawn or clarified to indicate that the Appeal Brief (filed February 13, 2002) is in compliance with 37 C.F.R. § 1.192(c).

The Answer alleges that the Status of Claims, Grouping of Claims, and Appendix sections of the Appeal Brief are incorrect. The Appellants respectfully disagree.

Status of Claims

The Answer alleges that the statement of the Status of Claims section of Appellants' Appeal Brief is incorrect. The Appellants respectfully disagree. This allegation in the Answer is also confusing in light of the Answer's agreement (on page 3, line 1) that Appellants' statement of the Issues section in the Appeal Brief is correct. The Answer alleges that the (Final) Office Action ("Action") dated September 19, 2001 contained the following rejections:

- 1). Claims 1-6, 13-14, and 17-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson.
- 2). Claims 15-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson.
- 3). Claims 7-12 were rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson.

The Appellants respectfully disagree. The Final Action dated September 19, 2001, from which their appeal was taken, only contained the following rejections:

- 1). Claims 1-6, 13-14, and 17-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson.

- 2). Claims 15-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Official notice.

Claims 1-20 are pending in the Application. Thus, claims 7-12, being neither objected to nor rejected, were viewed as allowed. It follows that the statement of the status of the claims contained in the Appeal Brief is correct based on the Action from which the Appeal was taken. Thus, the Answer is incorrect, confusing, and defective.

An Office Action is presumed to be complete in accordance with 37 CFR § 1.104. There was no indication in the Action of a rejection of claims 7-12. There was plainly no specific identification of any ground of rejection of claims 7-12 in accordance with MPEP § 707.07(f). It follows that the Final Action does not include a rejection of claims 7-12. Additionally, neither the Final Action nor the prior Office Action dated April 16, 2001 included the rejection of claims 7-9 under 35 U.S.C. § 102(e) as being anticipated by Anderson. Nor does the Final Action include a rejection of claims 15-16 under 35 U.S.C. § 103(a) as being unpatentable over Anderson alone as asserted in the Answer. Claims 15-16 were actually rejected in the Final Action under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Official notice. The Answer at pages 7-8 provides further evidence that this pending rejection is over Anderson in view of Official notice. Thus, the Answer incorrectly states the status of the claims on appeal.

The Answer is further confusing because the Answer's indicated Status of Claims does not correspond with the Answer's indicated Grounds of Rejection. For example, the Status of Claims indicates that claims 7-12 were rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson, whereas the Grounds of Rejection contrarily indicates that claims 7-9 were rejected under 35 U.S.C. § 103(a) as set forth in Paper No. 7.

The Answer is plainly incorrect, confusing, and defective. Thus, the Answer should either be withdrawn or clarified to indicate that the Status of Claims section of the Appeal Brief is correct and that the Appeal Brief is in compliance with 37 C.F.R. § 1.192(c).

Grouping of Claims

The Answer alleges that the Appeal Brief does not include a statement that the claims do not stand or fall together. The Appellants respectfully disagree. The Appeal Brief (beginning on page 4) includes a Grouping of Claims section which states that "No group of claims stand or fall together." Thus, the Appeal Brief includes a proper statement that the claims do not stand or fall together.

The Appeal Brief (in the Argument section thereof) also explains why the claims are separately patentable.

Thus, the Appeal Brief includes both a proper statement that the claims do not stand or fall together and presents arguments why the claims are separately patentable. It follows that the Answer incorrectly ascertains the grouping of claims on appeal.

Furthermore, where an Appeal Brief includes only one of either (a) a statement that the claims do not stand or fall together or (b) presents arguments why the claims are separately patentable, then the Appellants are to be notified of a noncompliance as per 37 C.F.R. § 1.192(d). Note MPEP § 1206 (page 1200-11, col. 1, first paragraph; August 2001 version). However, Appellants were not notified of any noncompliance. Nor were Appellants given any appropriate time period to correct any alleged defects in accordance with 37 C.F.R. § 1.192(d). Thus, it must be concluded that the Appeal Brief is in compliance with 37 C.F.R. § 1.192(c).

Therefore, the Grouping of Claims section in the Appeal Brief is correct. It follows that the Answer is incorrect, confusing, and defective. Thus, the Answer should either be withdrawn or clarified to indicate that the Grouping of Claims section of the Appeal Brief is correct and that the Appeal Brief is in compliance with 37 C.F.R. § 1.192(c).

Appendix of the Claims in the Appeal

The Answer alleges (on page 3) that claims 1-6 and 13-20 in the Appendix section of the Appeal Brief contain substantial errors. The Appellants respectfully disagree. Nor has the Answer indicated where the "substantial errors" allegedly occur. The Appellants respectfully submit that the Appeal Brief Appendix contains a correct copy of the claims involved in the appeal.

Furthermore, the Answer indicates that there is a correct copy of the claims in an Appendix to the Answer. However, Appellants' copy of the Answer includes no claim Appendix.

Again, the Answer is incorrect, confusing, and defective. Thus, the Answer should either be withdrawn or clarified to indicate that the Appendix section of the Appeal Brief is correct and that the Appeal Brief is in compliance with 37 C.F.R. § 1.192(c).

If necessary, then reconsideration is requested

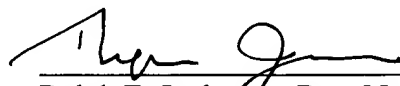
If a request for reconsideration is first required, then Appellants respectfully request reconsideration and withdrawal of the Examiner's Answer, or reconsideration and that the Answer be clarified to indicate that the Status of Claims, Grouping of Claims, and Appendix sections of the Appeal Brief are correct and that the Appeal Brief is in compliance with 37 C.F.R.

§ 1.192(c). If a request for reconsideration is first required, then this petition should be considered as such.

Conclusion

Appellants respectfully submit that the Examiner's Answer contains at least one impermissible new ground of rejection within the meaning of 37 C.F.R. § 1.193(a)(2) which prohibits the entry of a new ground of rejection in an Examiner's Answer. Appellants also respectfully submit that the Examiner's Answer is incorrect, confusing, defective. Thus, Appellants respectfully request that the Examiner's Answer dated May 7, 2002 either be withdrawn or both the new grounds of rejection therein be disregarded and the Examiner's Answer (or the record) be clarified to indicate that the Appeal Brief filed February 13, 2002 is in compliance with 37 C.F.R. § 1.192(c). Appellants respectfully request that their petition be granted for the reasons presented herein. The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000